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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,772	01/25/2001	Roger Edwards	C005	5011

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PATENT DEPARTMENT
MACROVISION CORPORATION
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EXAMINER

MOORTHY, ARAVIND K

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 03/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,772

Applicant(s)

EDWARDS, ROGER

Examiner

Aravind K Moorthy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The title of the invention is not descriptive.

A new title is required that is clearly indicative of the invention to which the claims are directed. The examiner suggests the title "Copy Protection of Digital Audio Compact Discs by Rendering Control Data Incorrect or Inaccurate".

Drawings

2. The drawings are objected to because drawings are labeled "SUBSTITUTE SHEET (RULE 26)".

That is a label for PCT drawings. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. Applicant is required to submit a proposed drawing correction in reply to this Office action.

3. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated.

A compact disc showing the spiral data track is not new to the art. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 2-12 and 14-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2 and 3 recite the limitation "incorrect data" in the claim. There is insufficient antecedent basis for this limitation in the claim. Claim 1 does not recite that the data is incorrect. For the sake of examining, the examiner assumes that the claim is referring to the control data. Claim 1 recites the limitation that data is rendered incorrect and/or inaccurate. If the data recited in claim 1 is "inaccurate" then there is a lack of antecedent basis. If the data is "incorrect", then there is no problem with antecedent basis.

Claims 14, 16, 21 and 23 recite the limitation "incorrect data" in the claim. There is insufficient antecedent basis for this limitation in the claim. There is insufficient antecedent basis for this limitation in the claim. Claim 13 does not recite that the data is incorrect. For the sake of examining, the examiner assumes that the claim is referring to the control data. Claim 13 recites the limitation that data is rendered incorrect and/or inaccurate. If the data recited in claim 13 is "inaccurate" then there is a lack of antecedent basis for the claims listed above. If the data is "incorrect", then there is no problem with antecedent basis.

Any claims not specifically addressed are rejected based on virtue of dependency.

5. Claims 24 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

Claims 24 and 25 make reference to the accompanying drawings. The claims do not make reference to a specific drawing, element in figure, abstract or disclosure.

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Claims 24 and 25 recite the term “substantially”; the examiner asserts that this renders the claim as indefinite.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 13-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The non-statutory matter is the “control data”. The “control data” is non-functional descriptive material. Data signals without more are non-statutory, as they do not fall within any of the statutory classes listed in 35 U.S.C 101.

Claim Objections

7. Claims 4-12, and 16-23 objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claim 4 recites, “a method as claimed in any preceding claim”, if claim 4 depends on claim 3 then there would multiple dependent claim depending on another multiple dependent claim.

Claim 9 recites, “a method as claimed in any preceding claim”, if claim 9 depends on claim 3 then there would multiple dependent claim depending on another multiple dependent claim.

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Claim 11 recites, "a method as claimed in any preceding claim", if claim 11 depends on claim 3 then there would multiple dependent claim depending on another multiple dependent claim.

Claim 12 recites, "a method as claimed in any preceding claim", if claim 12 depends on claim 3 then there would multiple dependent claim depending on another multiple dependent claim.

Claim 16 recites, "in any of claims 13 to 15", if claim 16 depends on claim 15 then there would multiple dependent claim depending on another multiple dependent claim.

Claim 21 recites, "in any of claims 13 to 20", if claim 21 depends on claim 15 then there would multiple dependent claim depending on another multiple dependent claim.

Claim 23 recites, "in any of claims 13 to 22", if claim 23 depends on claim 15 then there would multiple dependent claim depending on another multiple dependent claim.

Any claims not specifically addressed are rejected based on virtue of dependency.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4 and 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Sollish WO 98/08180 in view of Merriam-Webster's Collegiate Dictionary (hereinafter Webster).

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As to claims 1, 9, 13 and 21, Sollish discloses a method of copy protection of a digital audio compact disc, page 1 lines 4-6. Sollish discloses that control data usable by a data reader is encoded on the compact disc, see abstract. Sollish discloses a class of special patterns to be recorded onto the digital optical media, consisting of invalid channel bit sequences written on the digital optical media, page 18 lines 9-11.

Webster defines "invalid" as not valid. Webster defines "valid" as logically correct. The examiner asserts that if something is "invalid" then it is not logically correct. Thus the invalid symbols would have been incorrect.

As to claims 2 and 14, Sollish discloses that the incorrect data encoded onto the CD is either inaccessible to, or not generally read by, an audio player. Sollish discloses that if the CD is an unauthorized copy then the symbol is not detected, page 23 lines 26-27.

Webster defines "inaccessible" as not accessible. The word "accessible" is defined as capable of being reached. Webster defines "detectable" as to discover or determine the existence of. The examiner asserts that if you were not able to able to discover or determine the existence of the symbols then it would not be capable of being reached. The symbols used for copy protection then would have been inaccessible to the player.

As to claims 3 and 15, Sollish discloses that the incorrect data encoded onto the CD renders the disc generally unplayable by a data reader. A check is made for the presence of the non-copyable symbols (ambiguous symbol). If they are present, the software will have determined that the optical media is authentic and will execute the application. Otherwise, the software will have determined that the optical media is an unauthorized copy and will refuse to run, page 16 lines 2-9.

As per claims 4 and 16, Sollish discloses that the data encoded on the compact disc that has been rendered incorrect is navigation data. Sequential bytes of data are mapped to the series of symbols that are sequentially recorded on the data track of the CD, page 11 lines 5-23.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5, 11, 17 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sollish WO 98/08180 in view of Maeda et al U.S. Patent No. 5,153,861 in further view of Merriam-Webster's Collegiate Dictionary (hereinafter Webster).

As to claims 5 and 17, Sollish discloses that the data is rendered incorrect.

Sollish does not teach that the data is provided in the lead-in and identifies the position on the disc of the lead-out.

Maeda's invention teaches a recording/reproducing device where additional information concerning reproducing procedures, etc. edited by the user is recorded in the lead-in region on a recording medium, column 2 line 40-49. The TOC (table of contents) is formed in the lead-in region, column 4 lines 10-14. The TOC contents contains the start and end position of each track.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Sollish so that lead-in region would contain the invalid symbols and would identify the position of the lead-out. The examiner asserts that the end of the last track is going identify the position of the lead-out.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Sollish by the teaching of Maeda because it saves the user the conventional trouble of entering procedures for reproduction, etc. every time he/she places the recording medium in the recording/reproducing device, thereby resulting in an enhanced operability, column 3 lines 33-43.

As per claims 11 and 23, Sollish discloses data encoded on compact disc that is rendered incorrect.

Sollish does not teach that the data encoded on the compact disc that is rendered incorrect is data in the table of contents (TOC) of the compact disc.

Maeda teaches that a TOC area is formed as a lead-in region, column 4 lines 10-14. In the TOC area, the additional information concerning reproducing procedures, recording start position for each of the information, etc. recorded in the lead-in region can be read out and stored in the memory means without any necessity for the user to repeatedly the same additional information on preferred reproducing procedures etc, column 3 lines 16-32.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Sollish so that the invalid symbols would have been in the TOC. The TOC was formed as a lead-in region. The invalid symbols would have been used for copy protection.

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It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Sollish by the teaching of Maeda because it saves the user the conventional trouble of entering procedures for reproduction, etc. every time he/she places the recording medium in the recording/reproducing device, thereby resulting in an enhanced operability, column 3 lines 33-43.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K Moorthy whose telephone number is 703-305-1373. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail O Hayes can be reached on 703-305-9711. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

March 2, 2003


GAIL HAYES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100